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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/552,485 04/18/00 SINGER

C	1562/49502
EXAMINER	

HM22/0105

KENYON & KENYON
ONE BROADWAY
NEW YORK NY 10004

ART UNIT	PAPER NUMBER
BERNHARDT, E	5

DATE MAILED:

01/05/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-28 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

BEST AVAILABLE COPY

Art Unit: 1624

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to process of making mirtazapine, classified in class 540, subclass 555.
- II. Claims 10-18, drawn to process of making a piperazine compound, classified in class 544, subclass 365.
- III. Claims 19-24, drawn to process for purifying mirtazapine, classified in class 540, subclass 555.
- IV. Claims 25-28, drawn to mirtazapine and composition and use, classified in class 540, subclass 555; class 514 subclass 214.02.

The inventions are distinct, each from the other because of the following reasons: The different groups are expected to raise different issues of patentability as final product prepared in I or III is old as admitted by applicants and evidenced by the art of record. The process claims require different searches in the process art in view of the differing reaction conditions and/or use of reactants. Novelty, or obviousness of reactant used in I would also be a consideration in determining patentability of process of I in view of the recent Ochiai decision (37 USPQ 2d 1127). Product made in II is not product claimed in IV and thus raises separate issues. While product in IV is made by I and III it can be made employing processes known in the prior art. A **known** compound is not rendered novel by a process directed to its preparation. See for example In re Brown 173 USPQ 685; In re Thorpe 227 USPQ 964.

Art Unit: 1624


A telephone call was made to Mr. Lee on 9/11/00 and later on 1/03/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.


EMILY BERNHARDT
PRIMARY EXAMINER